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#10

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/025,395 02/18/98 RYDBECK

N P-4015.100

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EXAMINER

BANKS HAROLD M

ART UNIT

PAPER NUMBER

2745

DATE MAILED:

02/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Regards,

M.D. Banks-Harold
(703) 305-4379

Office Action Summary

Application No.
09/025,395

Applicant(s)
RYDBECK ET AL.

Examiner
Marsha D. Banks-Harold

Group Art Unit
2745



☒ Responsive to communication(s) filed on Dec 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) 1-10 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Information Disclosure Statement

1. The references listed in the Information Disclosure Statement submitted on 05/19/99 have been considered by the examiner (see attached PTO- 1449).

Drawings

2. The drawings are objected to because of the problems addressed in the attached PTO-948. Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. *Claims 17-19* are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 17-19**, the claim dependency is not clear since there is not a limitation “first and second memories” in claim 11. Therefore, for the purpose of this rejection, the

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examiner has assumed that claims 17-19 depend from claim 15 since claim 15 recites the limitation "first and second memories".

Further, for the purpose of enhancing a compact prosecution of the instant application, the rejection with respect to claims 17-19 is made based on the assumption presented above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. ***Claims 11-12 and 14*** are rejected under 35 U.S.C. 102(e) as being anticipated by Futami (GB 2308775A).

Regarding **claim 11**, Futami discloses a portable telephone set and entertainment unit with a wireless headset, where the entertainment unit is constituted by a CD, as disclosed on page 14, lines 6-11, which inherently provides support for the audio and video signals, since it is well known in the art the CDS are used for both audio and video signals, which reads on the claimed "cellular telephone having an entertainment module for playing pre-recorded audio and video signals". In addition, Futami discloses a radio telephone unit (12) used for the transmission and

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reception of communication information, as exhibited in FIG. 2, which reads on the claimed “transceiver”; a control unit (17) for controlling the operation of the radio telephone unit (12), as exhibited in FIG. 2, which reads on the claimed “microprocessor”; a transmission/reception unit (15) operatively connected to the radio telephone unit (12) and to the control unit (17) used for processing the signals transmitted and received by the radio telephone unit (12), as exhibited in FIG. 2, which reads on the claimed “signal processing unit”; and an audio reproduction unit (16) with a memory (e.g., cassette player, CD, etc.) operatively connected to the control unit (17) and the transmission/reception unit (15) used for storing the audio and the video signals for future playback, as exhibited in FIG. 2, which reads on the claimed “entertainment module”.

Regarding **claim 12**, Futami discloses everything claimed, as applied above (see **claim 11**, in addition, Futami inherently provides support for the memory being erasable and programmable, as evidenced by the fact that it is well known in the art for the memory of CDS to be erasable and programmable.

Regarding **claim 14**, Futami discloses everything claimed, as applied above (see **claim 11**, in addition, Futami inherently provides support for the memory being permanent and removable, as evidenced by the fact that it is well known in the art for the memory of CDS to be permanent and for the CDS to be removable.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. ***Claims 13 and 15-16*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Futami in view of well known prior art (MPEP 2144.03).

Regarding **claim 13**, Futami discloses everything claimed, as applied above (see **claim 12**), however, Futami fails to specifically disclose an input used for downloading information. However, the examiner takes official notice of the fact that it is well known in the art to use inputs for downloading information.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Futami by providing for the input for downloading information, for the purpose of providing a specific means used for obtaining information from various sources.

Regarding **claim 15**, Futami discloses everything claimed, as applied above (see **claim 11**), in addition, Futami discloses support for a memory that is programmable and erasable and where the memory is permanent. However, Futami fails to specifically disclose the memories are

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two separate memories. However, the examiner takes official notice of the fact that the use of RAM and ROM memories is well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Futami by providing for the two separate well known RAM and ROM memories, for the purpose of providing means necessary to provide the user of a communication device with the ability to separate stored information based on the need to change or not to change the stored information.

Regarding **claim 16**, Futami and well known prior art disclose everything claimed, as applied above (see **claim 15**), in addition, Futami inherently provides support for the memory being removable and interchangeable, as evidenced by the fact that it is well known in the art for CDS to be removable and thus interchangeable.

6. *Claims 17-18* are rejected under 35 U.S.C. 103(a) as being unpatentable over Futami in view of well known prior art (MPEP 2144.03) further in view of Benedetto et al. (U.S. Patent Number 4,591,661).

Regarding **claim 17**, Futami and well known prior art disclose everything claimed, as applied above (see **claim 15**), in addition, Futami discloses where the audio signals from the memory are directed to the earphone/microphone unit (2), as exhibited in FIG. 2, however the Futami combination fails to specifically disclose where the headset is connected to a headset port

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in the telephone, however, the examiner contends that this connection is well known in the art, as taught by Benedetto et al..

In a similar field of endeavor, Benedetto et al. discloses a portable cordless telephone transceiver-radio receiver. In addition, Benedetto et al. discloses where a headset (60) is connected to a jack receptacles 42-45, as disclosed at column 3, lines 8-10.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Futami combination by providing for the connection of the headset to the telephone, as taught by Benedetto et al. for the purpose of providing a means of electrically connecting the headset to the telephone.

Regarding **claim 18**, the Futami combination discloses everything claimed, as applied above (see **claim 15**), in addition Futami discloses where the control unit (17) shuts off the audio reproduction unit (16) based on a call being received, as disclosed on page 7, line 26- page 8, line 4.

7. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Futami in view of well known prior art (MPEP 2144.03) further in view of Chin (U.S. Patent Number 5,661,788) further in view of Kitamura (U.S. Patent Number 5,987,106).

Regarding **claim 19**, the Futami combination discloses everything claimed, as applied above (see **claim 15**), in addition Futami discloses where the audio output was stopped based on an incoming call, however, Futami fails to specifically disclose where a list of preferred callers was

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used to determine who to actually accept a call from and where the audio was impacted based on a preferred caller. However, the examiner contends that the acceptance of calls based on a preferred list in addition to the stopping of audio output in response to a preferred caller is well known in the art, as taught by Chin and Kitamura.

Regarding the preferred list of callers, in a similar field of endeavor, Chin discloses a method and system used for selectively altering user and answering preferred telephone calls. In addition, Chin discloses where a list of preferred callers are stored in selection memory (112) and where the list is used only to accept calls from those callers stored on the list.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Futami combination by providing for the preferred list of callers, as taught by Chin, for the purpose of avoiding undesired incoming telephone calls, as taught by Chin at column 1, lines 45-47.

Regarding the stopping of audio output in response to a preferred caller, in a similar field of endeavor, Kitamura discloses an automatic volume control system and method for use in a multi-media computer system. In addition, Kitamura discloses where the audio for audio generating components is muted based on the detection of a call from a priority caller, as disclosed at column 6, lines 37- column 7, line 7.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Futami combination by providing for the muting of audio generated by audio generating components based on the detection of a call from a priority caller,

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as taught by Kitamura, for the purpose of being able to provide different volume control strategies based on the priority level of a received call, as taught by Kitamura at column 1, lines 65-68.

Citation of Pertinent Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Tuoriniemi et al. (U.S. Patent Number 5,978,689) discloses a personal portable communication and audio system.

Conclusion

10. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-9508 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 11, 2021 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marsha D. Banks-Harold whose telephone number is (703) 305-4379. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reinhard Eisenzopf, can be reached on (703) 305-4711. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

MDB-H/mdB-h
February 9, 2000

Marsha D. Banks-Harold
MARSHA BANKS-HAROLD
PATENT EXAMINER